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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

06502.0381-00000

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on _____

Signature _____

Typed or printed name _____

Application Number

10/035,580

Filed

12/28/2001

First Named Inventor

Guy L. Steek, JR.

Art Unit

2193

Examiner

Chat C. Do

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 56,249

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Nathan A. Sloan
Signature

Nathan A. Sloan
Typed or printed name

202.408.4312
Telephone number

9/30/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT

Customer No. 22,852
Attorney Docket No. 06502.0381-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Guy L. STEELE, Jr.)	Group Art Unit: 2193
)	
Application No.: 10/035,580)	Examiner: Do, Chat C.
)	
Filed: December 28, 2001)	Confirmation No.: 2889
)	
For: FLOATING POINT MULTIPLIER)	
WITH EMBEDDED STATUS)	
INFORMATION)	

Mail Stop AF

Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Action mailed April 8, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed June 30, 2005.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-40 remain pending, with claims 1-40 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-40 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,995,991 to Huang et al. ("*Huang*"). The Examiner also provisionally rejected claims 1-6, 8-19, 21-32, and 34-40 under obviousness-type double patenting as being unpatentable over claims 1-37 in copending Application No. 10/035,584 ("*584*") in view of U.S. Patent No. 5,065,352 to Nakano ("*Nakano*").¹

I. The rejection of claims 1-40 under 35 U.S.C. § 102(b) as being anticipated by *Huang* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish anticipation with respect to claims 1-40 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims.

Claim 1 recites a combination including, for example,

an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand based upon data within the first floating point operand and data within the second floating point operand respectively; and ...

a resulting status embedded within the resulting floating point operand

(emphasis added).

The Examiner appears to assert that *Huang's* register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

Huang specifically distinguishes between a register and an operand, stating "each of the **registers** 116 and 118 has an **operand . . . portion** 116-1 and 118-1." (*Huang*, col. 6,

¹ Pending the withdrawal of the rejections under 35 U.S.C. § 102(b), Applicant will respond to the double patenting rejection as set forth in M.P.E.P. § 804(I)(B) or § 804.02. Applicant does not request review of these rejections by the Pre-Appeal Brief review board.

line 66- col. 7, line 1). Moreover, “**operands** X and Y [are] stored in **operand portions** 116-1 and 118-1 of **registers** 116 and 118.” (*Huang*, col. 7, lines 8-10). Even assuming that tag values x_tag and y_tag correspond to the claimed “data” and “status,” (which Applicant does not concede) the Examiner’s contention that *Huang*’s register 116 containing x_tag 116-2 constitutes the claimed “data within the ... operand” and “resulting status embedded within the resulting ... operand” is clearly contradicted by *Huang*. See, e.g., *RFR* at pp. 3-4.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant’s specification, which states “conditions are typically represented by flags that are stored in the floating point status register” (paragraph 026). Claim 1 specifically distinguishes over such structures, calling for “data within the ... operand” and a “resulting status embedded within the resulting ... operand.” See, e.g., Fig. 2, paragraph 045, and paragraph 046 of Applicant’s specification.

Accordingly, the Examiner’s position that *Huang*’s register 116 constitutes an “operand,” as recited by the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 of *Huang* do not constitute a teaching or suggestion of “data within the ... operand” or a “resulting status embedded within the resulting ... operand,” as recited by claims 1, 15, and 28 and required by dependent claims 2-14, 16-27, and 29-40.

Since *Huang* fails to teach each and every element of the claims, *Huang* cannot anticipate claims 1-40. Applicant requests the board of examiners to allow these claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan
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